

REMARKS

By this amendment, claims 4 and 5 are added for examination. Therefore, on entering this amendment, claims 1-5 are all the claims in the present Application.

Summary of the Office Action

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ayers (U.S. Patent No. 6,395,093) in view of Nakai et al. (U.S. Patent No. 4,155,826).

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ayers in view of Nakai et al. and further in view of Harris et al. (U.S. Patent No. 6,483,336).

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ayers in view of Harris et al. (U.S. Patent no. 6,483,336).

The Applicants traverse the rejections and request reconsideration.

Formal Matters

Applicant thanks the Examiner for initialing the references filed with the Information Disclosure Statement filed on September 12, 2003. Applicant also thanks the Examiner for accepting the drawings filed on September 12, 2003.

Please note that Applicants had claimed priority from JP 2002-267917 at the time of filing this Application. The priority document is submitted herewith. The Examiner is kindly requested to acknowledge the claim for foreign priority as well as the receipt of certified copies of priority document.

Prior Art Rejections

Rejection of Claim 1 under 35 U.S.C. § 103(a) based on Ayers in view of Nakai et al.

The Applicants respectfully submit that a skilled artisan would not have been motivated to combine the teachings of Ayers and Nakai. The Examiner contends that Nakai and Ayers are in the same field of endeavor. The Applicants respectfully disagree. Nakai is related to a process of surface treating molded articles. There is no mention (or a remote suggestions) regarding any teaching on motors. Further there is no suggestions or motivation in Ayers to modify the O-rings 25 and 27 to make it using a resin. A skilled artisan would not have been motivated to combine the teachings of Ayers and Nakai to make a vacuuming motor as in the present invention, as recited in claim 1.

The Federal Circuit has stated unequivocally that most if not all inventions arise from a combination of old elements. *In re Kotzab*, 99-1231 (CAFC June 2000), *citing In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Further, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *Id.*, *citing, In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998).

Other than generally asserting that it would have been obvious to make the O-ring of Ayers from the resin disclosed by Nakai, the Examiner has not shown any motivation to do so.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Kotzab*, 99-1231 (CAFC June 2000), citing *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. The court in *Kotzab* further accentuates that close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Id. quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Federal Circuit appears to be clearly talking about the kind of situation as in the present case. The Applicants respectfully submit that the combination of using a vacuum seal made of resin with the other elements recited in claim 1 is not disclosed or suggested by the combined teachings of Ayers and Nakai.

Further, claim 1 requires a vacuum seal. For example, vacuum seals 9a, 9b are disposed in the vacuum motor 4 so that it can be arranged out of the vacuum chamber 1. On the other hand, in Ayers, the motor 17 is generally usable in the atmosphere and is arranged in the enclosure 16 having a large space. Such a motor 17, does not include any vacuum seals.

Rejection of Claim 2 under 35 U.S.C. § 103(a) based on Ayers in view of Nakai et al. and further in view of Harris et al.

Without getting into the merits of the substance of the Examiner’s grounds for the rejection of claim 2, it is allowable at least by virtue of its dependency on claim 1. In addition,

Harris does not overcome the deficiency noted above in the combined teachings of Ayers and Nakai.

Further, the present invention, as recited in claim 2, requires that a middle sucking port for vacuuming air be provided at an interval between the vacuum seals at a central portion. However, in Ayers, the motor 17 does not have any middle sucking portion.

Rejection of Claim 3 under 35 U.S.C. § 103(a) based on Ayers in view of Harris et al.

Claim 3 (as amended) requires that the motor main body and the reduction gear main body be arranged in an atmosphere outside the vacuum chamber. The combined teachings of Ayers and Harris does not suggest the inventive combination of claim 3 with the motor main body and the reduction gear main body being outside the vacuum chamber.

New Claims

Claims 4-7 (dependant on claims 1 and 2, respectively) are presented for examination. They should be allowable at least based on their dependency. Additionally, the arguments cited above in relation to claim 3 are analogously valid for these claims.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. § 1.111
U.S. Application No.: 10/660,652

Attorney Docket No.: Q77465

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Chid S. Iyer
Registration No. 43,355

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: November 23, 2004